

DOCKET NO: 294227US0X PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :  
HARALD GROEGER, ET AL. : ATTN: APPLICATION DIVISION  
SERIAL NO: 10/593,567 :  
FILED: SEPTEMBER 20, 2006 :  
FOR: PROCESS FOR PREPARING :  
OPTICALLY ACTIVE AMINO ACIDS USING :  
A WHOLE-CELL CATALYST :

PETITION UNDER 37 C.F.R. §1.47(A)

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

SIR:

The undersigned Petitioners hereby request that the executed oath/declaration under 37 C.F.R. §1.63 submitted herewith be accepted in lieu of the fact that Prof. Werner Hummel, who is a named inventor on the above-identified application, refuses to sign the oath/declaration after numerous diligent and *bona fide* attempts have been made to obtain the signature thereof. Evidence substantiating these unsuccessful attempts, which have in fact been made to obtain a properly executed oath/declaration from Prof. Werner Hummel, are summarized in detail in the following "Statement of Facts," as attested to and executed by Ms. Sandra Wissel.

STATEMENT OF FACTS

On three separate occasions, Ms. Sandra Wissel mailed a copy of the enclosed oath/declaration to Prof. Werner Hummel, along with the enclosed accompanying letters dated August 22, 2006, October 2, 2006, and December 8, 2006. Successful delivery of the mailings of October 2, 2006, and December 8, 2006, are substantiated by the enclosed evidentiary mail return receipts with corresponding signature confirmation confirming receipt and acceptance of the oath/declaration by Prof. Werner Hummel.

Application No. 10/593,567  
Attorney Docket No. 294227US  
Petition under 37 C.F.R. §1.47(a)

Although I have made numerous diligent and *bona fide* attempts to obtain a properly executed oath/declaration from Prof. Werner Hummel, as of the date that this Statement of Facts was executed, a duly executed oath/declaration has not been received from Prof. Werner Hummel.

I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct.

  
Ms. Sandra Wissel

June 20, 2007  
Date

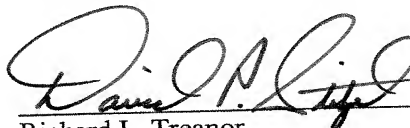
The refusal of Prof. Werner Hummel to duly execute the oath/declaration is evidenced by the forgoing diligent and *bona fide* attempts made by Ms. Sandra Wissel to obtain the signature thereof. It is readily apparent that Prof. Werner Hummel refuses to duly execute the oath/declaration, as substantiated by the enclosed evidentiary mail return receipts with corresponding delivery/signature confirmation, which confirm receipt and acceptance of the oath/declaration by Prof. Werner Hummel.

In accordance with 37 C.F.R. §1.47(a), enclosed herewith is the fee set forth in 37 C.F.R. §1.17(g), an executed Statement of Facts averring to the foregoing diligent and *bona fide* attempts made by Ms. Sandra Wissel to obtain a properly executed oath/declaration from Prof. Werner Hummel, accompanying documentary evidence substantiating these efforts, and an oath/declaration under 37 C.F.R. §1.63, which has been executed by the named inventors on the above-identified application, except for Prof. Werner Hummel, who refuses to sign.

Consequently, it is respectfully requested that this petition be GRANTED.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

  
Richard L. Treanor  
Attorney of Record  
Registration No. 36,379

Customer Number  
**22850**

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
(OSMMN 06/04)

David P. Stitzel  
Attorney of Record  
Registration No. 44,360

Degussa AG • P.O.Box 1345 • 63403 Hanau • Germany

**Herrn Professor  
Werner Hummel  
Claudiusstrasse 11**

**52445 Titz  
GERMANY**

Degussa AG  
Rodenbacher Chaussee 4  
63457 Hanau  
DEUTSCHLAND

T +49-6181-59-01  
F +49-6181-59-3030

[www.degussa.com](http://www.degussa.com)

22.Aug.2006

**Unser Zeichen 200410021 (früher: 040055 AM)  
Verfahren zur Herstellung von optisch aktiven Aminosäuren mittels  
eines Ganzzellkatalysators  
Validierung zur PCT-Patentanmeldung PCT/EP2005/002933**

Sehr geehrter Herr Professor Hummel,

zu Ihrer Information möchten wir Ihnen mitteilen, dass wir obige PCT-  
Anmeldung in folgenden Staaten validieren werden:

**CA, CN, JP, US; EP**

Wir bitten Sie, die beigefügten Formulare an den angekreuzten Stellen zu  
unterzeichnen und zu datieren (bitte in US-Schreibweise – MM/TT/JJJJ)  
und

**innerhalb von zwei Wochen**

an

**Degussa AG  
S-IPM-PAT  
Postcode 84/339  
Rodenbacher Chaussee 4  
63457 Hanau  
DEUTSCHLAND**

zurückzusenden.

Bitte lassen Sie auf dem Assignment für Canada zusätzlich einen **Zeugen**  
unterschreiben. Zeuge kann hierbei **jede** volljährige Person sein.

Kontakt:  
Sandra Wissel

Degussa AG  
Intellectual Property  
Management  
PATENTE & MARKEN  
Standort Hanau

S-IPM-PAT  
Unser Zeichen:  
200410021

T +49 6181-59-2016  
F +49 6181-59-4304

[ipm\\_pat\\_hanau@degussa.com](mailto:ipm_pat_hanau@degussa.com)

Besten Dank im Voraus.

Seite 02

Mit freundlichen Grüßen  
**Degussa AG**

gez. Dr. Stefan Retzow    gez. SandraWissel

Dieses Schreiben wurde vollautomatisch erstellt. Der Inhalt ist auch ohne Unterschrift verbindlich

Anlagen

CA-Assignment-Formular  
US-Declaration-Formular  
US-Assignment-Formular  
PCT-Veröffentlichung

[Letter from Degussa AG, Hanau, Germany, to Professor Werner Hummel, Titz, Germany,  
dated 22 August 2006]

**Our reference 200410021 (previously: 040055 AM)**

**Process for preparing optically active amino acids using a whole-cell catalyst**

**Validation for PCT patent application PCT/EP2005/002933**

Dear Professor Hummel,

We are writing to inform you that we are going to validate the abovementioned PCT application in the following states:

**CA, CN, JP, US; EP**

We would ask you to sign and date the attached forms at the places marked with a cross (please date in the US style – MM/DD/YYYY) and return them

**within two weeks**

to

**Degussa AG  
S-IPM-PAT  
Postcode 84/339  
Rodenbacher Chaussee 4  
63457 Hanau  
GERMANY.**

Please arrange for a witness to also sign the assignment for Canada. Witnesses can be any person of full age.

Many thanks in advance.

Yours sincerely

**Degussa AG**

signed Dr Stefan Retzow

signed Sandra Wissel

This letter was produced automatically and is valid even unsigned.

Enclosures

CA Assignment Form

US Declaration Form

US Assignment Form

PCT Publication

Degussa AG, Postfach 1345, 63403 Hanau

**Einschreiben mit Rückschein**

Herrn Professor  
Werner Hummel  
Claudiusstrasse 11

52445 Titz  
GERMANY

**Unser Zeichen 200410021 (früher: 040055 AM)  
Verfahren zur Herstellung von optisch aktiven Aminosäuren  
mittels eines Ganzzellkatalysators**

Sehr geehrter Herr Professor Hummel,

die erbetene Stellungnahme/Zusendung von Unterlagen liegt noch  
nicht vor.

Zur Vermeidung von unnötigen Kosten möchten wir Sie dringend bitten,  
die erbetene Stellungnahme/Zusendung nunmehr

**innerhalb von zwei Wochen**

an

**Degussa AG  
S-IPM-PAT  
Postcode 84/339  
Rodenbacher Chaussee 4  
63457 Hanau  
DEUTSCHLAND**

zurückzusenden.

Mit freundlichen Grüßen  
**Degussa AG**

Dieses Schreiben wurde vollautomatisch erstellt. Der Inhalt ist auch ohne Unterschrift verbindlich.

Anlagen

Kopie unseres Schreibens vom 22.08.06 samt Anlagen

Degussa AG  
Rodenbacher Chaussee 4  
63457 Hanau  
DEUTSCHLAND

T +49-6181-59-01  
F +49-6181-59-3030

[www.degussa.com](http://www.degussa.com)

02.Oct.2006

Kontakt:  
Sandra Wissel

Degussa AG  
Intellectual Property  
Management  
PATENTE & MARKEN  
Standort Hanau

S-IPM-PAT  
Unser Zeichen:  
200410021

T +49 6181-59-2016  
F +49 6181-59-4304

[ipm\\_pat\\_hanau@degussa.com](mailto:ipm_pat_hanau@degussa.com)

[Registered letter with advice of delivery from Degussa AG, Hanau, Germany, to Professor Werner Hummel, Titz, Germany, dated 2 October 2006]

**Our reference 200410021 (previously: 040055 AM)**

**Process for preparing optically active amino acids using a whole-cell catalyst**

Dear Professor Hummel,

We have still not received the statement/documents requested.

To avoid unnecessary expenses, we would urge you to return the statement/documents requested

**within two weeks**

to

**Degussa AG  
S-IPM-PAT  
Postcode 84/339  
Rodenbacher Chaussee 4  
63457 Hanau  
GERMANY.**

Yours sincerely

**Degussa AG**

This letter was produced automatically and is valid even unsigned.

Enclosures

Copy of our letter of 22.08.06 including enclosures



Deutsche Post 

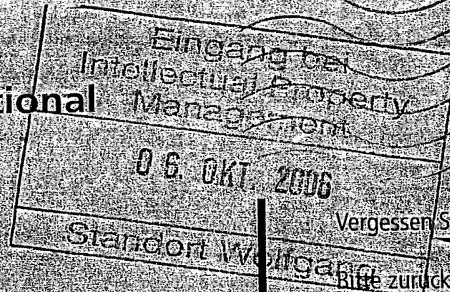
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**Patentabteilung**

Vorname

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Strasse und Hausnummer oder Postfach

**63457 Hanau**

Postleitzahl, Ort

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**04.10.06**

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Strasse und Hausnummer oder Postfach

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Postleitzahl, Ort

**63457 HANAU**

### Empfangsbestätigung

Name und Vorname in GROSSBUCHSTABEN

**NUMMEL**

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Datum

**04.10.06**

Empfangsberechtigter: Unterschrift



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Fee Paid

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Remember to include your address

Dear Customer,

Please fill in your full address on the right.

Please return to:

Degussa AG

Surname

Please also complete the following boxes  
overleaf:

Patent Department (Wissel)

Forename

- "Addressee"
- "Consignment No./Ident code" if applicable

Rodenbacher Chaussee 4

Street and house number or PO box

63457 Hanau

Post code, town

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Management  
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Location Wolfgang

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☐ Authorized representative

☐ Other authorized recipient

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I have handed over the consignment to the  
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Date

04.10.06

Post office employee: Signature

X [signed]

Addressee

Surname, forename/company name

PROF. HUMMEL

Street and house number or PO box

CLAUDIUSSTRASSE 11

Post code, town

52445 TITZ

Acknowledgment of receipt

Surname and forename in CAPITAL LETTERS

Hummel, W.

I confirm that I have received the consignment today.

Date

04.10.06

Authorized representative: Signature

X W. Hummel

Degussa AG, Postfach 1345, 63403 Hanau

**Einschreiben mit Rückschein**

Herrn Professor  
Werner Hummel  
Claudiusstrasse 11

52445 Titz  
GERMANY

Degussa AG  
Rodenbacher Chaussee 4  
63457 Hanau  
DEUTSCHLAND

T +49-6181-59-01  
F +49-6181-59-3030

[www.degussa.com](http://www.degussa.com)

08.Dez.2006

**Unser Zeichen 200410021 (früher: 040055 AM)  
Verfahren zur Herstellung von optisch aktiven Aminosäuren  
mittels eines Ganzzellkatalysators**

Sehr geehrter Herr Professor Hummel,

wir kommen zurück auf unsere Schreiben an Sie vom 22. August 2006  
sowie unsere Erinnerung vom 2. Oktober 2006.

die erbetene Zusendung von der unterzeichneten Unterlagen liegt uns noch  
immer nicht vor.

Zur Vermeidung von unnötigen Kosten sowie Vermeidung eines Rechts-  
verlustes möchten wir Sie dringend bitten, die erbetenen unterzeichneten  
Formulare nunmehr

**umgehend**

an

**Degussa AG  
S-IPM-PAT  
Postcode 84/339  
Rodenbacher Chaussee 4  
63457 Hanau  
DEUTSCHLAND**

zurückzusenden.

Mit freundlichen Grüßen  
**Degussa AG**

Dieses Schreiben wurde vollautomatisch erstellt. Der Inhalt ist auch ohne Unterschrift verbindlich.

**Anlagen:** Kopie unseres Schreibens vom 22.08.06 samt Anlagen + Kopie  
Erinnerung vom 02.10.2006

Kontakt:  
Sandra Wissel

Degussa AG  
Intellectual Property  
Management  
PATENTE & MARKEN  
Standort Hanau

S-IPM-PAT  
Unser Zeichen:  
200410021

T +49 6181-59-2016  
F +49 6181-59-4304

[ipm\\_pat\\_hanau@degussa.com](mailto:ipm_pat_hanau@degussa.com)

[Registered letter with advice of delivery from Degussa AG, Hanau, Germany, to Professor Werner Hummel, Titz, Germany, dated 8 December 2006]

**Our reference 200410021 (previously: 040055 AM)**  
**Process for preparing optically active amino acids using a whole-cell catalyst**

Dear Professor Hummel,

We refer to our letter to you dated 22 August 2006 and our reminder dated 2 October 2006.

We have still not received the signed documents requested.

To avoid unnecessary expenses and loss of a right, we would urge you to return the signed forms requested

**without delay**

to

**Degussa AG**  
**S-IPM-PAT**  
**Postcode 84/339**  
**Rodenbacher Chaussee 4**  
**63457 Hanau**  
**GERMANY.**

Yours sincerely  
**Degussa AG**

This letter was produced automatically and is valid even unsigned.

Enclosures: Copy of our letter of 22.08.06 including enclosures + copy of reminder of 02.10.2006

Eingang bei  
Intellectual Property  
Management  
Vergessen Sie I  
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Bitte zurücksch  
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Vorname Nachname  
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Straße und Hausnummer oder Postfach  
63457 Hamm  
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[illegible]

200410021

911-008-000 Stand: 10/04 Vom Absender auszufüllen

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Dear Customer,

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Please return to:

Degussa AG PAT

Surname

Please also complete the following boxes  
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Mrs Wissel

Forename

- "Addressee"
- "Consignment No./Ident code" if applicable

Rodenbacher Chaussee 4

Street and house number or PO box

[bar code]  
H00043353Z

63457 Hanau

Post code, town

Received by  
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Management  
13 DEC. 2006

Location Wolfgang



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Delivery note

- ☒ Addressee                      ☐ Spouse  
☐ Authorized representative  
☐ Other authorized recipient

(Substitute recipient according to NATIONAL LETTER  
or NATIONAL PACKET/EXPRESS terms)

I have handed over the consignment to the  
authorized recipient.

Date

09.12.06

Post office employee: Signature

X [signed]

Addressee

Surname, forename/company name

PROFESSOR HUMMEL

Street and house number or PO box

CLAUDIUSSTRASSE 11

Post code, town

52445 TITZ

Acknowledgment of receipt

Surname and forename in CAPITAL LETTERS

Hummel, W.

I confirm that I have received the consignment today.

Date

09.12.06

Authorized representative: Signature

X [signed]